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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,321	02/06/2004	Xiaofan Lin	200310312-1	8539

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EXAMINER	
JABR, FADEY S	
ART UNIT	**PAPER NUMBER**
3628	

NOTIFICATION DATE	DELIVERY MODE
01/02/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/774,321	LIN ET AL.	
	Examiner	Art Unit	
	Fadey S. Jabr	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 September 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-27* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Status of Claims

Claim **16** has been amended. Claims **1-27** remain pending and are again presented for examination.

Response to Arguments

1. Applicant's amendment filed 12 September 2007 with respect to 35 U.S.C. 112, second paragraph, has been fully considered and is therefore withdrawn.

2. Applicant's arguments filed 12 September 2007 have been fully considered but they are not persuasive.

3. Applicant argues that the combination of Shuster and Miller cannot be used to reject claim 1 because Shuster and Miller cannot be combined. Applicant goes on to argue that Shuster does not teach or even suggest actually performing the digital music file to measure metrics or to determine the price for a license. Examiner notes that in the broadest reasonable interpretation, Shuster's teaching that other defects in the copy, such as background hiss indicating that the data has once been stored in analog, or encoding defects such as pops may also influence the price calculation...thus, the licensing program is able to calculate a price for a license based on the measured metrics (0038), teaches determining a quality value for a target software based on performance of the target software. Further, in response to applicant's argument that the cited references cannot be combined, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references.

Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

4. Regarding claims **3, 9, 14** and **20**, Applicant did not properly traverse the official notice of comparing values by dividing them, or to use mathematical operations to manipulate values. Therefore, it is now considered admitted prior art.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims **1-2, 4-8, 10-11, 13, 15-19** and **21-27** are rejected under 35 U.S.C. 103(a) as being unpatentable over Shuster, Pub. No. US2005/0097059 A1 in view of Miller et al, Pub. No. US2004/0261070 A1, hereinafter referred to as Shuster and Miller, respectively.

As per **Claims 1, 5-7, 10, 16-17, 22 and 25**, Shuster discloses a licensing system and method comprising:

- computing a licensing fee for the target software based on the quality value (0013, 0015, 0037-0038).

Shuster fails to disclose a processor that stores operation logs of a target software, measures a performance level of the target software based on the operation logs; and determine a quality value for the target software based on the performance level. Shuster however does disclose

measuring the quality of digital content and determining the licensing cost based on the quality of the digital content. Moreover, Miller teaches storing the pertinent monitoring data and determining the performance of the software where the software's performance is based on many performance characteristics (0007, 0018, 0028-0029). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method and system of Shuster and store and monitor the performance data of the software being tested as taught by Miller, because it allows the system to license better quality software at a higher rate.

As per **Claims 2, 4, 18-19, 23 and 26**, Shuster fails to disclose comparing the performance of the target software to performance of another software. However, Miller teaches comparing the performance of the software to determine if it met an expected performance (0007). The expected performance comes from previous versions of the software being tested. Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method and system of Shuster and include comparing the target software to another comparable software as taught by Miller, because it allows the system to set benchmarks for comparison.

As per **Claim 8**, Shuster fails to disclose computing an absolute value for the quality value. However, Miller teaches monitoring the performance of the software to determine the number of defects per hour (0028-0029). Further, it is old and well known in the art at the time of the applicant's invention to provide comparison values in terms of absolute values. Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention

to modify the method and system of Shuster and include providing values in terms of an absolute value, because it allows the system to provide the user with comparison data in numerical terms.

As per **Claim 11**, Shuster fails to disclose determining a quality value based on a factor selected from the group consisting of accuracy level... However, Miller teaches determining a quality value of the software based on a performance level (0028). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method and system of Shuster and include determining a value of the software based on one of several characteristics as taught by Miller, because it allows the system to evaluate the software on many aspects of performance.

As per **Claims 13, 15, 21, 24 and 27**, Shuster fails to *explicitly* disclose adjusting a base licensing fee based on the quality value. However, Shuster discloses computing a price for a license for the downloaded file based on the measured metrics. For example, the price would be higher for a newer version of the file than the earlier version (0038). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method and system of Shuster and include adjusting the license fee based on the quality of the file, because it allows the system to charge a higher fee for better quality digital content.

7. Claims **3, 9, 12, 14** and **20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Shuster in view of Miller as applied to claims 1 and 16 above, and further in view of Official Notice.

As per **Claims 3, 9, 14 and 20**, Shuster fails to disclose dividing an error rate associated with the other software by an error rate associated with the target software; and multiplying the quality value by a first constant and adding the result to a second constant. However, Miller teaches error rates (0028-0029). Further, the Examiner takes Official Notice that it is old and well known in the art at the time of the applicant's invention to compare values by dividing them, or to use mathematical operations to manipulate values. Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method and system of Shuster and include using mathematical operations to compare and manipulate values, because it allows the system to compare values.

Furthermore, the difference between determining performance metrics of software as disclosed by Shuster and Miller, and the specific components of the applicant's disclosed system are only found in the non-functional descriptive material and are not functionally involved in the system components recited. The dividing of error rates or multiplying values by constants would be performed the same regardless of the descriptive material since none of the components explicitly interact therewith. Limitations that are not functionally interrelated with the useful acts, structure, or properties of the claimed invention carry little or no patentable weight. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Ngai*, 70 USPQ2d 1862 (CAFC 2004); *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would also have been obvious to a person of ordinary skill in the art at the time of applicant's invention to include any specific manipulation of values because such

data does not functionally relate to the components in the system claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

As per **Claim 12**, Shuster fails to disclose computing a value based on at least one point measurement over a timeframe that is substantially equal to or less than a predetermined time period. However, the Examiner takes Official Notice that it is old and well known in the art at the time of the applicant's invention to test software over an extended period of time in order to determine software issues. Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method and system of Shuster and include testing data over an extended period of time, because it allows the system to determine the software's quality and performance over a period of time where many of the software issues can become apparent.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fadey S. Jabr whose telephone number is (571) 272-1516. The examiner can normally be reached on Mon. - Fri. 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Fadey S Jabr
Examiner
Art Unit 3628

FSJ

Please address mail to be delivered by the United States Postal Service (USPS) as follows:

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(571) 273-1516 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to the Customer Service Window, Randolph Building, 401 Dulany Street, Alexandria, VA 22314

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PRIMARY EXAMINER